

REMARKS

This is in response to the Office Action dated September 21, 2004.

Claim 51 is currently amended. Claims 1-10, 44, and 48-57 remain pending in this application.

§102 Rejection of the Claims

Claims 1-4, 7, 10, 44 and 50 were rejected under 35 USC § 102(b or e) as being anticipated by Hsu et al. (U.S. Patent No. 6,016,442, hereinafter "Hsu") or Conley et al. (U.S. Patent No. 6,718,198, hereinafter "Conley").

Clarification Concerning the Conley Reference

The Office Action states that claims 1-4, 7, 10, 44 and 50 are rejected as being anticipated by Hsu and "Conley et al USPN 617198." Applicant believes that the Examiner intended to cite Conley, U.S. Patent No. 6,718,198, and this response is prepared accordingly. Applicant respectfully requests a clarification or confirmation in the next official communication.

Claim 1

Applicant respectfully traverses the rejection and submits that neither Hsu nor Conley provides the recited subject matter. The Office Action asserts that "(e)ach reference teaches a communicator that communicates with an implantable device" In contrast, claim 1 recites an implantable device including, among other things, means for detecting a patient activation request originating from external to the implantable device. Applicant is unable to find in Hsu or Conley, among other things, such an implantable device including the means for detecting the patient activation request from external to the implantable device.

Additionally, Applicant is unable to find in Hsu or Conley an implantable device including means for updating automatically an atrial arrhythmia event status periodically throughout the duration of a detected atrial arrhythmia event episode, as recited in claim 1.

Applicant respectfully requests reconsideration and allowance of claim 1.

Claims 2-4, 7, and 10

Applicant respectfully traverses the rejection of claims 2-4, 7, and 10. Claims 2-4, 7, and 10 are dependent on claim 1. Thus, the discussion for claim 1 above is incorporated herein to support the patentability of claims 2-4, 7, and 10.

Applicant respectfully requests reconsideration and allowance of claims 2-4, 7, and 10.

Claim 44

Applicant respectfully traverses the rejection and submits that neither Hsu nor Conley provides the recited subject matter. The Office Action asserts that “(e)ach reference teaches a communicator that communicates with an implantable device” In contrast, claim 44 recites an implantable device including, among other things, means for detecting a patient activation request originating from external to the implantable device. Applicant is unable to find in Hsu or Conley, among other things, such an implantable device including the means for detecting the patient activation request from external to the implantable device.

Additionally, Applicant is unable to find in Hsu or Conley an implantable device including means for generating audible tone messages within the implantable device, as recited in claim 44.

Applicant respectfully requests reconsideration and allowance of claim 44.

Claim 50

Applicant respectfully traverses the rejection of claim 50. Claim 50 is dependent on claim 44. Thus, the discussion for claim 44 above is incorporated herein to support the patentability of claim 50.

Applicant respectfully requests reconsideration and allowance of claim 50.

§103 Rejection of the Claims

Claims 5-6, 8-9, 48-49 and 51-57 were rejected under 35 USC § 103(a) as being unpatentable over Hsu or Conley.

Rejection Using Conley

Applicant respectfully traverses the obviousness rejection using Conley. Applicant respectfully submits that Conley is not available for combination in obviousness rejections pursuant to the changes in 35 USC § 103 after the American Inventor's Protection Act of 1999. The assignments on record for the present application and the patent application leading to Conley provide evidence of the requisite obligation of assignment to avoid their combination in a rejection under 35 USC § 103(c).

The assignment of present application (U.S. Serial No. 09/839,122) was recorded on July 2, 2001 on Reel 011947, Frames 0718-0722, with the United States Patent and Trademark Office. Conley (U.S. Patent No. 6,718,198) is a division of U.S. Serial No. 09/382,292, now issued as U.S. Patent No. 6,449,504. The assignment for U.S. Patent No. 6,449,504 was recorded on November 18, 1999 on Reel 010410, Frames 0824-0827, with the United States Patent and Trademark Office.

Applicant respectfully requests reconsideration and allowance of claims 5, 6, 8, 9, 48, 49 and 51-57.

Claims 5, 6, 8, and 9

Applicant respectfully traverses the rejection of claims 5, 6, 8, and 9. Claims 5, 6, 8, and 9 are dependent on claim 1. Thus, the discussion for claim 1 above is incorporated herein to support the patentability of claims 5, 6, 8, and 9.

Additionally, Applicant respectfully traverses the obviousness rejection of claims 5, 6, 8, and 9 as a form of Official Notice for stating what would have been obvious without support of a reference. The Office Action states:

Applicant differs merely in reciting the activator switch (magnetic reed) the transmission frequency (audible), which are considered conventional in the art. To have employed these techniques of communication in the Hsu and Conley devices would have been obvious.

Applicant timely traverses such assertion pursuant to M.P.E.P. 2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Applicant respectfully requests a clarification of this rejection in the next official communication or alternatively, the withdrawal of the rejection.

Applicant respectfully requests reconsideration and allowance of claims 5, 6, 8, and 9.

Claims 48 and 49

Applicant respectfully traverses the rejection of claims 48 and 49. Claims 48 and 49 are dependent on claim 44. Thus, the discussion for claim 44 above is incorporated herein to support the patentability of claims 48 and 49.

Additionally, Applicant respectfully traverses the obviousness rejection of claims 48 and 49 as a form of Official Notice for stating what would have been obvious without support of a reference. The Office Action states:

Applicant differs merely in reciting the activator switch (magnetic reed) the transmission frequency (audible), which are considered conventional in the art. To have employed these techniques of communication in the Hsu and Conley devices would have been obvious.

Applicant timely traverses such assertion pursuant to M.P.E.P. 2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Applicant respectfully requests a clarification of this rejection in the next official communication or alternatively, the withdrawal of the rejection.

Applicant respectfully requests reconsideration and allowance of claims 48 and 49.

Claims 51

Applicant has amended claim 51 to better describe the recited subject matter, Insofar as the rejection is applied to claim 51, Applicant respectfully traverses the rejection and submits that Hsu does not provide the recited subject matter. For example, Applicant is unable to find that Hsu teaches or suggests, along other things, a patient controlled hand-held external activator as recited in claim 51.

Applicant respectfully requests reconsideration and allowance of claim 51.

Claims 52-57

Applicant respectfully traverses the rejection of claims 52-57. Claims 52-57 are dependent on claim 51. Thus, the discussion for claim 51 above is incorporated herein to support the patentability of claims 52-57.

Additionally, Applicant respectfully traverses the obviousness rejection of claims 53-57 as a form of Official Notice for stating what would have been obvious without support of a reference. The Office Action states:

Applicant differs merely in reciting the activator switch (magnetic reed) the transmission frequency (audible), which are considered conventional in the art. To have employed these techniques of communication in the Hsu and Conley devices would have been obvious.

Applicant timely traverses such assertion pursuant to M.P.E.P. 2144.03 and requests a reference to support the assertion or an affidavit of personal knowledge by the Examiner. Applicant respectfully requests a clarification of this rejection in the next official communication or alternatively, the withdrawal of the rejection.

Furthermore, as to claim 56, Applicant is unable to find that Hsu teaches or suggests an external activator comprising a tone detector adapted to detect a tone and an activator processor adapted to decode the detected tone.

Applicant respectfully requests reconsideration and allowance of claims 52-57.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

VICTOR T. CHEN ET AL.

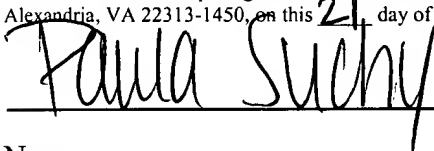
By their Representatives,

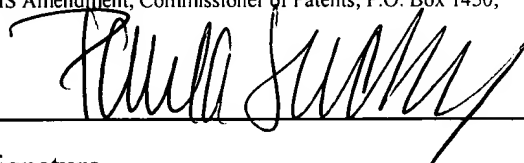
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of December, 2004.


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